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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,769	10/13/2000	Steven A. Weiss	28265-PA	1069

7590 12/01/2001

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EXAMINER

ASHBURN, STEVEN L

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 12/01/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/687,769

Applicant(s)

WEISS, STEVEN A.

Examiner

Steven L Ashburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

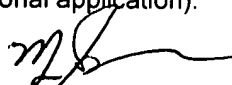
- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.


MARK SAGER
PRIMARY EXAMINER

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DETAILED ACTION

CLAIM REJECTIONS - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4, states, "rewarding success by transport to a player's designated site". Does the claim mean physically moving to another location? The term's use in Claim 2 suggest so. However, it is more likely the applicant intends to claim electronically linking to another network server using uniform resource locator (URL). Correction is required.

Claim 5 employs the phrase "rewarding success by personal redemption". The language leaves the thing that is redeemed indefinite. A voucher? The person? Correction is required.

CLAIM REJECTIONS - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-4, 6, 7, 9-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Eggleston et al., U.S. Patent 6,061,660 (May 9, 2001).

Eggleston discloses an on-line system for allowing sponsors and retailers to offer promotional games to consumers over Internet websites. The system reduces the sponsor's effort by supplying and managing pre-fabricated promotional programs via a third-party host. Eggleston discloses the following features common to the claimed invention:

- a) Posting information about a plurality of gaming devices on a wide area network (WAN). See figs. 8, 9 and col. 13:42-50. (Claims 1)
- b) Posting on the WAN information about potential promotions, contests and awards. See figs. 8, 9 and cols. 12:21-13:5. (Claims 1, 7)
- c) Displaying procedures correlating gaming device use to attain awards, promotions and contests. See figs. 8, 9 and cols. 12:21-13:5^{and 13:42-50,} (Claim 1) -mas
- d) Updating the promotions, contests and awards as they are changed or awarded. See figs. 10-12, 14 and cols. 14:26-15:55. (Claim 10)
- e) Displaying, playing and rewarding awards, contests and promotions remotely over a network. See fig. 19 and cols. 13:43-14:5. (Claims 2, 8, 9, 10, 11, 12, 15)
- f) Delivering awards. See fig. 14 and cols. 21:29-22:32. (Claim 13)
- g) Rewarding success using digital vouchers. See col. 13:55-67. (Claims 3, 14)
- h) Posting new and updated games on the network. See cols. 14:26-15:15. (Claims 6, 10)

CLAIM REJECTIONS - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al., U.S. Patent 6,061,660 (May 2001) in view of Goldberg et al., U.S. Patent 5,823,879 (Oct. 1998).

Eggleston is describes above. It discloses all of the features of the invention except for personally redeeming awards at a casino (Claim 5) and providing updates to a machine at a casino (Claim 8).

Notably, Eggleston discloses both these features, but not in association with a casino. First, Eggleston

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describes the personal redemption of awards obtained ^{through} ~~though~~ an online game from a retailer. (Claim 5)

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See fig. 21. Second, Eggleston describes updating contest information. See figs. 10-12, 14; cols. 14:26-15:55. (Claim 8) Hence, the only element missing from Eggleston is a casino.

Internet websites sponsored by casinos are notoriously well known. When searching the Internet, advertisements linking users to gambling websites are unavoidable. Goldberg discloses a system for offering casino games, promotions and contests to remote users over the Internet. See cols. 3:56-4:62; 5:47-67. Goldberg is analogous to Eggleston because the both system combine on-line gaming and promotional services. In view of Goldberg, it would have been obvious to one skilled in the art at the time of the invention to employ to system disclosed in Eggleston to use casinos as sponsors and employ casino devices as games. As suggested by Eggleston, the resulting system would allows casinos to take advantage of the Internet to provide a convenient means of fulfilling awards and collecting customer data in games offered to remote users.

CONCLUSION

The following prior art made is considered pertinent to applicant's disclosure of record, but not relied upon:

- a) Leason et al., U.S. Patent 6,251,017 (June 2001) discloses a system for redeeming on-line awards.
- b) Kelly et al., U.S. Patent 6,015,344 (Jan. 2000) discloses an network prize redemption system.
- c) Hedges et al., U.S. Patent 4,467,424 (Aug. 1984) discloses a system for remotely gaming over a network.
- d) Walker et al., U.S. Patent 6,001,016 (Dec. 1999) discloses a system for remote play of casino gaming devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven L Ashburn whose telephone number is 703 305 3543. The examiner can normally

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be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703 308 1148. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305 3590 for regular communications and 703 308 3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1078.



Steven Ashburn
November 14, 2001



MARK SAGER
PRIMARY EXAMINER

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.